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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,422	06/30/2003	Sameer Desai	RUS0119	8088

7590 03/05/2007
VALEO, INC.
Intellectual Property Department
4100 North Atlantic Boulevard
Auburn Hills, MI 48326

EXAMINER

CIRIC, LJILJANA V


ART UNIT	PAPER NUMBER
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3744

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/608,422	Applicant(s) DESAI ET AL.	
	Examiner Ljiljana (Lil) V. Ciric 	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24, 2006 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on April 24, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,793,012 B2 has been reviewed and is accepted. The terminal disclaimer has been recorded, as previously noted in the Advisory Action mailed on May 12, 2006.

Affidavit

3. The affidavit under 37 CFR 1.132 filed on May 24, 2006 is insufficient to overcome the rejection of claims 1 through 30 based upon Fang et al. as set forth in the last Office action because: the affidavit fails to clearly set forth for the record that the instant application and the Fang et al patent were commonly owned at the time of invention of the instant invention—in particular, paragraph #11 is not clear as written because of grammatical informalities and also because it twice refers to “the above referenced patent application” while TWO patent applications (and not just one) were previously referenced in the affidavit; a simpler but clearer statement that “Application A and United States Patent No. B were, at the time the invention of Application A was made, commonly owned by Company Z” would suffice. See MPEP 706.02(I)(2). Paragraph #13 of the affidavit is also not clear as written. Please note that it is also not clear whether the aforementioned affidavit is trying to establish common ownership only, or to show that any invention disclosed but not claimed in Fang et al. was derived from the

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inventive entity of the instant application and is thus not an invention “by another”, or whether the affidavit was intended to be an oath or declaration under 37 CFR 1.130 stating that the instant application and the Fang et al. reference are currently owned AND that the inventive entity named in the instant application is the prior inventor under 35 USC 104. The aforementioned affidavit, due to its lack of clarity, meets none of these. Also please note that, in the reply filed on April 24, 2006, applicant’s attorney stated that the Fang et al. patent was assigned to Valeo Thermique Moteur as recorded on April 28, 2004 (almost ten months after the filing of the instant application) and also stated the present invention is assigned to Valeo, Inc. In the reply filed on April 24, 2006, applicant’s attorney then stated that “At the time of *the claimed invention* (which one?), both Valeo Thermique Moteur and Valeo, Inc. were commonly held by Valeo, SA, and *in reality* (what does this mean?) the assets of both Valeo Thermique Moteur and Valeo, Inc., including the present invention, were commonly owned *and/or obligated to be owned* (and, if the latter, thus *NOT* commonly owned?) at the time the claimed invention was made.” The aforementioned statements lacked clarity and thus raised questions which may be obviated via an affidavit such as described in MPEP 706.02(I)(2)(C)--namely by an affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization. Again, the affidavit filed on May 24, 2006 does not address any of the aforementioned issues clearly and in full and is therefore insufficient.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 5 and 7 through 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 7 through 18 all recite limitations referring to the "size" of the tubes, but it is not clear which dimension(s) of the tubes are encompassed by this term. For example, it is not clear whether the limitation "smaller in size than the first and second tubes" in lines 10-11 of claim 7 refer to the individual diameters of the tubes, to the tube thicknesses, to the tube lengths, to the volume of each of the first tubes and/or the second tubes, to some other dimensions of the tubes, or to some combination(s) thereof, thus rendering indefinite the metes and bounds of protection sought.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 through 30 are rejected under 35 U.S.C. 103(a) as being obvious over Fang et al. (US 6,793,012, previously of record).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the

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inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).


The heat exchanger as claimed in the instant application and the heat exchanger disclosed by Fang et al. differ only in there being an inlet and an outlet on the first end for the first fluid and in the plurality of third tubes being smaller in size than the first and second tubes, with these differences being obvious modifications to one skilled in the art at the time of invention as suggested by Fang et al. (i.e., see column 5, lines 11-58)

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric whose telephone number is 571-272-4909. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel, may be reached at 571-272-4909.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ljiljana (Lil) V. Ciric
Primary Examiner
Art Unit 3753